

1 KEKER & VAN NEST LLP
2 ROBERT A. VAN NEST - #84065
3 rvannest@kvn.com
4 CHRISTA M. ANDERSON - #184325
5 canderson@kvn.com
6 MICHAEL S. KWUN - #198945
7 mkwun@kvn.com
8 633 Battery Street
9 San Francisco, CA 94111-1809
10 Tel: 415.391.5400
11 Fax: 415.397.7188

KING & SPALDING LLP
DONALD F. ZIMMER, JR. - #112279
fzimmer@kslaw.com
CHERYL A. SABNIS - #224323
csabnis@kslaw.com
101 Second St., Suite 2300
San Francisco, CA 94105
Tel: 415.318.1200
Fax: 415.318.1300

8 KING & SPALDING LLP
9 SCOTT T. WEINGAERTNER
10 (Pro Hac Vice)
11 sweingaertner@kslaw.com
12 ROBERT F. PERRY
13 rperry@kslaw.com
14 BRUCE W. BABER (Pro Hac Vice)
15 1185 Avenue of the Americas
16 New York, NY 10036
17 Tel: 212.556.2100
18 Fax: 212.556.2222

IAN C. BALLON - #141819
ballon@gtlaw.com
HEATHER MEEKER - #172148
meekerh@gtlaw.com
GREENBERG TRAURIG, LLP
1900 University Avenue
East Palo Alto, CA 94303
Tel: 650.328.8500
Fax: 650.328.8508

14 Attorneys for Defendant
15 GOOGLE INC.

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17 UNITED STATES DISTRICT COURT
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19 NORTHERN DISTRICT OF CALIFORNIA
20
21 SAN FRANCISCO DIVISION

20 ORACLE AMERICA, INC.,

21 Plaintiff,

22 v.

23 GOOGLE INC.,

24 Defendant.

Case No. 3:10-CV-03561-WHA

**GOOGLE'S SUPPLEMENTAL
COPYRIGHT LIABILITY TRIAL BRIEF
PURSUANT TO MARCH 26, 2012 ORDER**

Judge: Hon. William Alsup

The Court has asked Google to address Oracle's contentions regarding an alleged field-of-use restriction and its purported applicability to the Apache Harmony project. As explained below, the Apache Software Foundation ("Apache") licenses Apache Harmony to the public without *any* field-of-use restrictions, and rejected Sun's attempt to impose such a limit on the use of Apache Harmony. Notwithstanding these facts, Sun has never sued Apache, and has never asserted that the use of the Apache Harmony libraries is conditioned on a field-of-use limitation. To the contrary, Jonathan Schwartz, Sun's CEO at the relevant times, has testified that Apache Harmony can be used for any purpose so long as the resulting product is not called "Java." There is no field-of-use restriction on the use of Apache Harmony. Oracle's field-of-use restriction argument is a red herring.

I. The Apache Harmony project was launched in August 2005, and licensed without any field-of-use restrictions.

In August 2005, Apache announced the Apache Harmony project, the goal of which was to create an open-source product compatible with J2SE. This project followed open-source efforts by other groups to achieve the same goal, such as GNU Classpath from the Free Software Foundation. Apache licenses Apache Harmony to the public for free under version 2 of the open source Apache License. This license does not have any field-of-use restrictions.¹

II. Apache never agreed to a field-of-use restriction, and Sun never objected to the use by Apache and others of the Java language APIs.

Jonathan Schwartz, Sun's CEO from 2006 to 2010, testified that,

¹ See Apache License, Version 2.0, available at <http://www.apache.org/licenses/LICENSE-2.0.html>. Version 2.0 of the General Public License, the open source license that governs use of GNU Classpath, similarly has no field-of-use restriction. See General Public License, Version 2.0, available at <http://www.gnu.org/licenses/gpl-2.0.html>.

1 [REDACTED]
2 [REDACTED]
3 Schwartz Depo. at 49:11-50:10; *see also id* at 47:17-23 [REDACTED]
4 [REDACTED]
5 [REDACTED] However, "In order to call
6 your product Java, and in order to feature to the marketplace that you were a Java phone or a
7 Java device and to get that brand, you needed to pass that the—the TCKs, the Testing [sic]
8 Compatibility Kits." *Id.* at 46:17-21.
9

10 Starting in August 2006, Apache attempted to obtain from Sun a license to the J2SE 5.0
11 technology compatibility kit ("TCK"). The license *to the TCK* (i.e. to the suite of compatibility
12 tests) that Sun offered to Apache would have limited the use of Apache Harmony to certain
13 fields of use. Apache, however, never agreed to such a limitation.

14 In May 2007, with no TCK license in place for Apache Harmony, Schwartz publicly
15 stated, "there is no reason that Apache cannot ship Harmony today." Trial Ex. 2341; Schwartz
16 Depo. at 51:15-22. According to Schwartz, however, Apache "wanted, in fact, to be able to call
17 Harmony Java. And we held firm and said no, that's our core value. If you want to call it Java,
18 you can pay, you know, the fee to go run the test and compatibility kits, and that enable you to
19 tell your customers that you actually had a licensed Java runtime. But absent that statement,
20 they, you know, couldn't say that, and they were frustrated by it." Schwartz Depo. at 52:16-23.

21 In June 2007, Apache wrote an open letter to Sun, requesting a TCK license without a
22 field-of-use restriction. That same month, in an effort spearheaded by Oracle Corporation,
23 twelve signatories, including a Google Engineering VP, urged Schwartz to grant Apache an
24 unencumbered TCK license. *See* Trial Ex. 2347. Sun, however, refused. Because Apache was
25 unwilling to agree any field-of-use restriction, it *did not license* the TCK. As a result, Apache
26 *did not agree to—and never has agreed to—a field-of-use limitation for Apache Harmony.*

27 The lack of a TCK license, however, did not prevent others from using Apache Harmony:
28 [REDACTED]

1 [REDACTED]
 2 [REDACTED]
 3 [REDACTED]
 4 [REDACTED]
 5 [REDACTED]
 6 [REDACTED]

7 Schwartz Depo. at 83:15-84:7. Even without a TCK license, “[a]nybody else who wanted to go
 8 create their own runtime, whether it was Apache Harmony or GNU Classpath, was free to do so;
 9 they just couldn’t call it Java.” *Id.* at 182:2-5. Mr. Schwartz will testify that commercial
 10 products from IBM and Hewlett-Packard used the Apache Harmony implementation of the Java
 11 language APIs without objection from Sun.

12 **III. There is no field-of-use restriction for Apache Harmony.**

13 The dispute between Apache and Sun was about branding, and the ability to say that
 14 Apache Harmony is Java compatible. The end result was that Apache *did not agree* to a field-of-
 15 use restriction. Notwithstanding Apache’s refusal to limit the field of use for Apache Harmony,
 16 Sun never sued Apache. In fact, Sun’s CEO has testified that *anyone* can use the Apache
 17 Harmony code (and thus its implementation of the Java language API specifications)—so long as
 18 it does not call its product “Java.”

19 Finally, Google in any event does not call Android “Java.” Google has used the term
 20 “Java” in its nominative, non-brand sense to describe, for example, how developers can use the
 21 free and open Java programming language to write applications for the Android platform. That,
 22 however, is not an attempt to brand the Android product “Java.” Indeed, Oracle’s complaint
 23 does not include a trademark infringement count. Oracle’s field-of-use restriction argument is
 24 irrelevant and should be rejected.

25 Dated: March 27, 2012

KEKER & VAN NEST LLP

26 /s/ Robert A. Van Nest
 27 By: ROBERT A. VAN NEST

28 Attorneys for Defendant
 GOOGLE INC.